

REMARKS

Claims 1-26 and 37-50 are pending.

Claims 1-26 stand rejected.

Claims 27-36 have been canceled without prejudice or disclaimer of the subject matter recited therein.

Claims 15-25 have been amended to properly depend from claim 14. Claims 15-25 have not been amended for reasons of patentability.

Claim Rejections - 35 U.S.C. § 103

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koppelman et al. – Publication No. US 2004/0039640 (hereinafter “*Koppelman*”), in view of U.S. Patent No. 6,105,001 to Masi (hereinafter “*Masi*”). Applicants respectfully traverse the rejection.

The Examiner indicated in the January 3, 2007 Office Action that the response filed by Applicants on October 16, 2006 was not fully responsive “because of the following omission(s) or matter(s): The applicant must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any or the replied references.” January 3, 2007 Office Action.

Applicants respectfully submit that the October 16, 2006 Response filed by the Applicants was fully responsive.

In the July 17, 2006 Office Action, the Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) over *Koppelman* in view of *Masi*.

MPEP § 2142 states that, “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP, § 2142. “If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” *Id.*

Applicants pointed out in Applicants' October 16, 2006 Response that under 35 U.S.C. § 103(c)(1), *Koppelman* cannot be used to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 because (i) *Koppelman* is a reference by virtue of 35 U.S.C. § 102(e) and (ii) *Koppelman* and the present application were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely Trilogy Development Group, Inc. (The specific facts and relevant statutory and MPEP section are recited again below for convenience.)

Masi was not cited as anticipating the present invention under 35 U.S.C. § 102.

Thus, with *Koppelman* being ineligible as a reference under 35 U.S.C. § 103(a) and *Masi* not supporting a rejection under 35 U.S.C. § 102, Applicants respectfully submit that a *prima facie* case of obviousness was not made by the Examiner. Applicants also stated that "new claims 37 - 50 are allowable for at least the same reasons as claims 1-26." See, Applicants' Response, October 16, 2006, p. 12.

By establishing that the Examiner had not made a *prima facie* case to reject the present application, Applicants respectfully submit that Applicants met their burden of response under 37 C.F.R. § 1.111. Accordingly, Applicants respectfully submit that Applicants' October 16, 2006 Response was fully responsive to the July 17, 2006 Office Action.

Facts and Remarks from Applicants' October 16, 2006 Response:

Title 35 U.S.C. § 103(c)(1) states that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections(e),(f), and(g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The filing date of the present application is March 15, 2001. The publication date of *Koppelman* is February 26, 2004. The publication date of the parent application of *Koppelman* (Application No. 09/081,857, now U.S. Patent No. 6,662,164 (referred to as the "164 Patent")) is December 9, 2003. Thus, *Koppelman* and the '164 Patent qualify as prior art only under 35 U.S.C. § 102(e).

The present application is assigned to Trilogy Development Group, Inc. of Austin, TX.

The '164 Patent is assigned to the same assignee, Trilogy Development Group, Inc. In accordance with the Manual of Patent Examining Procedure § 306:

In the case of a division or continuation application, a prior assignment recorded against the original application is applied >(effective)< to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications.

Thus, the assignment to Trilogy Development Group, Inc. of the '164 Patent is also applied to *Koppelman*.

Since *Koppelman* and the claimed invention of the present application were, at the time the claimed invention was made, subject to an obligation of assignment to the same person, as evidenced by the common assignment to Trilogy Development Group, Inc. in the assignment documents filed in the '164 Patent and the Present Application, in accordance with 35 U.S.C. § 103(c)(1), *Koppelman* cannot be used as part of a rejection based upon 35 U.S.C. § 103.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Applicants respectfully submit that new claims 37 - 50 are allowable for at least the same reasons as claims 1-26.

CONCLUSION

In view of the remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

FILED ELECTRONICALLY

Respectfully submitted,

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